

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



*VW
AFJ*

Applicant(s): Ji-Young Kim

Examiner: Vu, Kieu D.

Serial No.: 09/752,393

Group Art Unit: 2173

Filed: December 28, 2000

Docket: 678-580 (P9655)

For: **METHOD FOR CREATING
CUSTOMIZED MENU IN A
PORTABLE RADIO TELEPHONE**

Dated: February 15, 2006

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

TRANSMITTAL OF APPELLANT'S BRIEF ON APPEAL

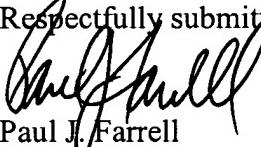
Sir:

Enclosed please find APPELLANT'S BRIEF.

Also enclosed is a check in the amount of \$500.00 to cover the appeal fee.

If the enclosed check is insufficient for any reason or becomes detached, please charge the required fee under 37 C.F.R. §1.17 to Deposit Account No. 04-1121. Also, in the event any additional extensions of time are required, please treat this paper as a petition to extend the time as required and charge Deposit Account No. 04-1121. TWO COPIES OF THIS SHEET ARE ENCLOSED.

Respectfully submitted,


Paul J. Farrell
Reg. No.: 33,494

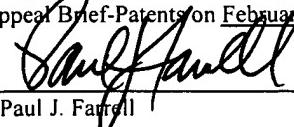
Attorney for Applicant(s)

DILWORTH & BARRESE, LLP
333 Earle Ovington Blvd.
Uniondale, New York 11553
516-228-8484

CERTIFICATE OF MAILING 37 C.F.R. §1.8(a)

I hereby certify that this correspondence (and any document referred to as being attached or enclosed) is being deposited with the United States Postal Service as first class mail, postage paid in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450, Mail Stop Appeal Brief-Patents on February 15, 2006.

Dated: February 15, 2006


Paul J. Farrell

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants: Ji-Young Kim

Group Art Unit: 2173

Serial No.: 09/752,393

Examiner: VU, Kieu D.

Filed: December 28, 2000

Docket: 678-580 (P9655)

For: **METHOD FOR CREATING
CUSTOMIZED MENU IN A
PORTABLE RADIO TELEPHONE**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

REAL PARTY IN INTEREST

The real party in interest is Samsung Electronics Co. Ltd., the assignee of the subject application, having an office at 416, Maetan-dong, Yeongtong-gu, Suwon-si, Gyeonggi-do, Republic of Korea.

RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge and belief, there are no currently pending related appeals, interferences or judicial proceedings.

02/21/2006 MAHED1 00000010 09752393

01 FC:1402

500.00 OP

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8 (a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to the: Mail Stop Appeal Brief-Patents Commissioner for Patents, Alexandria, VA 22313-1450, on February 15, 2006.

Dated: February 15, 2006

Paul J. Farrell

STATUS OF CLAIMS

Of Claims 1-9, Claims 1-9 stand finally rejected and constitute the claims on appeal. A copy of the appealed claims is contained in the Claims Appendix.

For the purposes of this appeal, Claims 2-4 stand or fall together with Claim 1, Claims 6-7 stand or fall together with Claim 5, and Claim 9 stands or falls together with Claim 8. Independent Claims 1, 5, and 8 are method claims.

STATUS OF AMENDMENTS

Although a Response dated October 17, 2005, containing an amendment to Claim 1, was filed subsequent to the final rejection dated July 15, 2005, the Examiner stated that this amendment would not be entered for purposes of this appeal.¹ Thus, Claims 1-9 as amended by the Response dated April 13, 2005 are pending for the purposes of this appeal and are contained in the Claims Appendix.

SUMMARY OF CLAIMED SUBJECT MATTER

The present application relates to a method for creating a separate menu, i.e., a “user-customized menu,” in a portable radio telephone, and teaches methods for creating and using the created user-customized menu (e.g., see Specification, Page 2, Lines 24-26, Page 3, Lines 1-9; and Page 7, Lines 20-26; and FIG. 4). The user-customized menu includes a user-customized menu index and corresponding menus such as an “initial screen” menu (see, Specification, Pages 6, Line 26 through Page 7, Line 11; and FIG. 4).

¹ See Advisory Action dated November 15, 2005

These corresponding menus also correspond to menus displayed on the main menu shown in FIG. 2 of the present application (c.f., “initial screen” in FIGs. 2 and 5). Thus, the user-customized menu according to the present invention simplifies the selection of menus and reduces the number of key entries required by a user to select a menu or submenu (e.g., see, Specification, Page 9, Lines 1-6).

As defined by Claim 1, the present invention is drawn to a method for creating a user-customized menu in a portable radio telephone having a menu table in which service menus for a user are stored in association with corresponding indexes (Specification, Page 4, Lines 13-14; Page 6, Lines 1-3; Page 7, Lines 13-18; and FIG. 4). The method teaches upon receipt of a user-customized menu creating key, switching an operating mode of the portable radio telephone to a user-customized menu creating mode (Specification, Page 6, Lines 5-7 and 11-14 and FIG. 3). The method teaches receiving a user-customized menu index in the user-customized menu creating mode (Pages 6, Lines 19-20 and 26, and FIG. 3). The method teaches after receiving the user-customized menu index, receiving a main menu index or a sub-menu index (Specification, Page 7, Lines 1-11; and FIGs. 3 and 4). The method teaches after receiving the main menu index or the submenu index, storing the main menu index or the submenu index in association with the user-customized menu index (Specification, Pages 6, Lined 26 through Page 7, Line 18; and FIGs. 3 and 4).

As defined in Claim 5, the present invention is drawn to a method for creating a user-customized menu in a portable radio telephone (Specification, Page 4, Line 13-14;

Page 6, Lines 1-3; Page 7, Lines 13-18; and FIG 4). The method teaches upon receipt of a user-customized menu creating key, switching an operating mode of the portable radio telephone to a user-customized menu creating mode (Specification, Page 6, Lines 5-7 and 11-14; and FIG. 4). The method teaches displaying a user-customized menu index input request message for requesting a user to input a user-customized menu index of a desired user-customized menu (Specification, Page 6, Lines 14-16). The method teaches after displaying the user-customized menu index input request message, receiving a user-customized menu index from the user (Page 6, Lines 19-20 and Page 7, through Lines 14-15; and FIG. 3). The method teaches displaying a menu index input request message for requesting the user to input a menu index corresponding to user-customized menu contents desired to be stored in the received user-customized menu index (Specification, Page 7, Lines 1-3; and FIG. 4). The method teaches after displaying the menu index input request message, receiving from the user a main menu index or a sub-menu index (Specification, Page 6, Lines 14-16; Page 7, Lines 14-16; and FIG. 4). The method teaches storing the received menu index in association with the user-customized menu index (Specification, Page 6, Lines 26 through Page 7, Line 18; and FIGs. 3 and 4).

As defined in Claim 8, the present invention is drawn to a method for creating a user-customized menu in a portable radio telephone (Specification, Page 4, Lines 13-14; Page 6, Lines 1-3; Page 7, Lines 13-18; FIG. 4). The method teaches creating a menu table by designating menu indexes corresponding to service menus for a user (Specification, Page 5, Lines 24-26; Page 6, Lines 107 and FIGs. 3 and 4). The method teaches upon receipt of a user-customized menu creating request from the user to create a

user-customized menu, switching an operating mode of the portable radio telephone to a user-customized menu creating mode (Specification, Page 6, Lines 507 and 11-14; and FIG. 3). The method teaches upon receipt of an index to be designated for the user-customized menu in the user-customized menu creating mode, receiving a service menu selected by inputting a main menu index or a sub-menu index and mapping the received index to the service menu (Specification, Page 6, Lines 19-20; and Page 6, Line 26 through Page 7 , Line 11; and FIGs. 3 and 4). The method teaches storing the mapped service menu in the menu table in association with the index received for the user-customized menu (Specification, Page 7, Lines 13-18; and FIG. 4).

GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

Claims 1-9 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,877,746 (hereinafter Parks) in view of U.S. Patent No. 5,479,476 (hereinafter Finke-Anlauff).

ARGUMENT

I. THE COMBINATION OF PARKS AND FINKE-ANLAUFF FAILS TO RENDER OBVIOUS THE INVENTION AS CLAIMED IN CLAIM 1.

Independent Claim 1 was said to be rendered unpatentable by the combination of

Parks and Finke-Anlauff. (See, Paragraph 3, at Page 2, of the Office Action dated July 15, 2005.).

Parks relates to a multi-function office system and, more particularly, to a user interface system for a computer system that comprises a grid of possible user functions, and teaches a user selecting one of the options displayed, and displaying the corresponding suboption that enables the user to set features of the telephone as the user desires (e.g., see, Column 1, Lines 7-10; Column 9, Lines 33-46; and Column 10, Lines 34-38). Parks further teaches many option menus have suboptions (Column 10, Lines 34-38) and that all of the suboptions are arranged vertically (Column 12, Lines 8-9). Parks also teaches selecting a mail setup menu 73 allows a user to select among various suboptions using decision boxes 74 which can be selected by placing an “X” in the box, and that if no “X” is placed in the box, the feature is not selected (Column 12, Lines 37-43). In other words, Parks teaches selecting a menu and thereafter being able to select or modify a suboption such as a “receive fax” option, a “receive voicemail” option, and a dial type (e.g., pulse or tone) in a multi-function office apparatus such as that shown in FIG. 1 (e.g., see FIG. 6 and Column 18, Lines 5-10). Accordingly, as taught by Parks, a user can access a menu and thereafter select a suboption to change its setting (such as the number of rings before answering) (e.g., see, FIG. 8), in which case the system would configure itself accordingly (i.e., set the number of rings before answering).

Finke-Anlauff discloses a mobile telephone having a plurality of operating characteristics and means for adjusting said operating characteristics (Column 1, Lines 8-11).

It is stated that Parks teaches each and every limitation of Claims 1-9, except that “Parks differs from the claim [sic] in that Parks does not teach that menu the [sic] customization can be applied to a portable radio phone,” which the Examiner states is taught by Finke-Anlauff (e.g., see, Office Action dated July 15, 2005, Pages 2-3 and paragraph 3).

The present application relates to a method for creating a separate menu i.e., a “user-customized menu,” in a portable radio telephone, and teaches methods for creating and using the created user-customized menu (e.g., see Specification Pages 2-3, 5, and 7, and FIGs. 3 and 5). The user-customized menu includes a user-customized menu index and corresponding menus (e.g., see, Specification and FIG. 5) which are selected by the user. These corresponding menus (e.g., an alarm setting menu, etc., as shown in FIG. 4 of the present invention) also correspond to menus displayed on the main menu shown in FIG. 2 of the present invention (c.f., FIGs. 2 and 4). Accordingly, a user can select menus and/or submenus from the menu shown in FIG. 2 of the present invention, which the user expects to, or desires to, use most frequently, and create the user-customized menu shown in FIG. 4 (e.g., see Specification, Pages 7, 8, and 9, and FIGs. 3 and 5). Thus, the user-customized menu simplifies the selection of menus and reduces the number of key entries required by a user to select a menu or submenu by displaying a menu only including those menus or submenus which are selected by the user (Specification, Pages 2 and 9). Thus, according to the present invention as recited in the Claims, if the user desires to display the submenu item of “Alarm Setting” (as shown in

the bottom of FIG. 2 of the present invention) without selecting a main menu (e.g., the “Time Setting” menu of FIG. 2) and thereafter a submenu (e.g., the “Alarm Setting” menu of FIG. 2), the user can create a user-customized menu (as shown in FIG. 4) having an “Alarm Setting” menu which can be conveniently accessed and which is given a location that corresponds with the user-customized menu index selected by the user.

To create the user-customized menu, after switching to a user-customized menu creating mode, the user first enters a user-customized menu index and thereafter enters a main-menu index and/or a submenu index. This is more clearly illustrated with reference to the flowchart shown in FIG. 4 of the present invention. Thus, the present invention, as defined by the Claims, differs from Parks and Finke-Anlauff in that the present invention at least teaches creating and using a separate menu, i.e., a user-customized menu, while Parks merely teaches adjusting a multi-function office machine’s settings, such as the number of rings before answering (e.g., see, Parks, Column 3, Lines 22-45 and Column 9, Lines 29-39) and Finke-Anlauff merely teaches adjusting operating characteristics of a mobile telephone (e.g., see, Finke-Anlauff, Column 1, Lines 7-10). Accordingly, the combination of Parks and Finke-Anlauff fails to teach or even fairly suggest the recitations of Claim 1.

a. It is the position of the Examiner that the combination of Parks and Finke-Anlauff teaches each and every limitation of Claim 1².

Claim 1 recites upon receipt of a user-customized menu creating key, switching

² e.g., see the Office Action dated July 15, 2005, pages 2-3, paragraph 3.

an operating mode of the portable radio telephone to a user-customized menu creating mode; receiving a user-customized menu index in the user-customized menu creating mode; after receiving the user-customized menu index, receiving a main menu index or a sub-menu index; and after receiving the main menu index or the submenu index, storing the main menu index or the submenu index in association with the user-customized menu index.

However, the combination of Parks and Finke-Anlauff fails to teach or suggest upon receipt of a user-customized menu creating key, switching an operating mode of the portable radio telephone to a user-customized menu creating mode; receiving a user-customized menu index in the user-customized menu creating mode; after receiving the user-customized menu index, receiving a main menu index or a sub-menu index; and after receiving the main menu index or the submenu index, storing the main menu index or the submenu index in association with the user-customized menu index, as recited in Claim 1.

1. The combination of Parks and Finke-Anlauff fails to teach or suggest a user-customized menu index and a main menu index and/or a submenu index.

The indexes, as recited in Claim 1, have been equated with the “suboptions” as taught by Park (e.g., see, Office Action dated July 15, 2005, Pages 5-6, Paragraph 4 and Office Action dated January 13, 2005, Pages 5-6, Paragraph 3). Further it is stated “though Parks uses the word ‘suboption’ instead of index, both Parks and the present

application teaches [sic] creating customized menu [sic] based on existing menu functions” (Office Action dated January 13, 2005) and that “Parks teaches ‘a suboption is selected (i.e. inputted) (col 17, lines 50-60)’”, Page 5, middle (Office Action, dated July 15, 2005, Page 5, middle).

As defined by the Specification of the present invention and in response to several Office Actions in this case, the main menu index and the submenu index are numerical indexes used to designate contents to be stored in the received user-customized menu index (e.g., see Specification, Paragraph beginning on Line 26, Page 6, and FIGs. 2 and 4 and Amendment dated April 29, 2004, Page 4, bottom). The main menu index and corresponding sub-menu indexes are shown with reference to FIG. 2 of the present invention. Thus, a main menu index of “8” corresponds with a “Time Setting” menu of the main menu illustrated in FIG. 2. Each main menu index can have a corresponding numerical sub-menu index; thus, a main menu index of “8” and a corresponding submenu-index of “2” would correspond to an “Alarm Setting” sub-menu (e.g., see, Specification, middle page 7 and FIGs. 2 and 4). In a similar manner, the Specification teaches using a main-menu index and a sub-menu index of 1, 1, respectively, would indicate a “bell volume” sub-menu with a menu index of 1, 1 (e.g., see middle page 7 and FIGs. 2 and 4). Hence, one skilled in the art would realize that a given sub-menu index has a corresponding menu index. Thus, by entering a main menu index and a sub-menu index of “1” and another “1,” respectively, the user can select a “bell volume” sub-menu.

Furthermore, as defined by the Specification of the present invention, the user-

customized menu index is a numerical index of a user customized menu to which the main-menu index and/or option sub-menu index are mapped (e.g., see Specification, middle of Page 7 and FIG. 4). Thus, as taught by the present invention, the user-selected main-menu index and optional sub-menu index are mapped to a user-selected user-customized menu index of a user-customized menu (e.g., see, Specification Page 7, middle and FIG. 4). Accordingly, the selected menu and/or submenu is mapped to a selected location in the user-customized menu.

In contrast, the suboptions, as taught by Parks, merely represent the capabilities of the system (e.g., see, Column 17, Lines 56-59) and can be selected by the user by placing an “X” so that a user can graphically “tell at a glance whether the circuitry of the integrated office system 10 has been configured,” for example, “to delete outgoing facsimile transmissions after they are sent” (e.g., see, Column 21, Lines 54-60 and reference numeral 96 of FIG. 10). Parks teaches other suboptions, such as a “[r]eceive faxes” suboption and a print faxes suboption which can be selected by placing an “X” in a decision box in front of the suboption (e.g., see, Column 12, lines 6-16 and paragraph beginning on line 52). Thus, as taught by Parks, if an “X” is removed from a decision box in front of a suboption, the integrated office system 10 configures the circuitry so that no faxes are received (e.g., see Column 12, Lines 60-67). Parks further teaches suboptions 77 which can be selected and thereafter a user can enter “appropriate data” in an associated data box (76 or 77) or text box (e.g., see Column 13, Lines 54-60, Column 14, Lines 4-20 and FIG. 6). In the latter example, Parks teaches a “user can type in the requested information using keyboard (12) when the appropriate suboption text box is

highlighted," and that "[w]hen a fax is transmitted, the information is recalled and provided to the modem 34 for transmission along with other data being sent. In this manner, the integrated office system is customized to the user's needs and preferences"

(Column 14, Lines 4-19; emphasis added). In other words, the suboptions of Parks allow a user to customize items such as a fax header, the number of rings before answering, and whether faxes are deleted after printing. However, the suboptions as taught by Parks fail to teach or suggest a main menu index, a submenu index, and/or a user-customized main menu index, as recited in Claim 1.

2. The combination of Parks and Finke-Anlauff fails to teach or suggest a user-customized menu creating mode.

It is asserted that the user-customized menu creating mode, as recited in Claim 1, is disclosed in Column 9, Lines 26-29 and Column 17, Lines 42-50 of Parks³. As defined by the preamble of Claim 1, the method teaches a "method for creating a user-customized menu" (emphasis added) and the Specification of the present invention teaches creating "a separate menu i.e., a "user-customized" menu (e.g., see Specification, Page 2, bottom; Page 7, middle; and Page 9, top). In other words, the user-customized menu is "created" in the user-customized menu creating mode, as recited in Claim 1. The above-cited passages of Parks, upon which the Examiner relies to support his rejection of Claim 1, respectively read as follows:

"Each of the elements (Mail, Phone, Fax and Copy) have a setup option or mode

³ See, Office Action dated July 15, 2005, Page 2, Paragraph 3.

which allows the user to customize various aspects of the selected feature, e.g., pulse or tone dialing for the telephone.” (Col. 9, Lines 26-29, emphasis added.)

“Using the navigation button 19 in the manner described above, a user selects an option. The first time the Phone feature is selected, and occasionally thereafter, a user will likely want to customize the phone features. To accomplish this, the user selects the PHONE SETUP tab 87 using the navigation button 19 or trackball 32. When the PHONE SETUP tab 87 is selected, the PHONE SETUP menu 88 is displayed in the workspace 60.” (Col. 17, Lines 42-50.)

These passages merely teach customizing phone features such as pulse or tone dialing (e.g., see Parks, FIG. 8) using a menu-based system. This is similar to the Examiner’s characterization of Finke-Anlauff: “Finke-Anlauff teaches [a] mobile telephone having groups of user adjustable operating characteristics which comprises [sic] the user customization of telephone features from a menu” (Office Action dated July 15, 2005, Page 4, middle; emphasis added). In this regard, with reference to FIG. 8 of Parks, it is seen that Parks teaches when the “PHONE SETUP tab 87 is selected, the PHONE SETUP menu 88 is displayed in the workspace 60” and various settings such as the “[r]ings before answer” or the dial type can be set (Parks, Column 17, Lines 46-50). In other words, the user can “customize the phone features” of the integrated office system 10 of Parks. However, a user-customized menu creating mode, as recited in Claim 1, is neither taught nor suggested by Parks. Moreover, Finke-Anlauff does not cure this deficiency. It is also respectfully submitted that the flowcharts, such as the one

shown in FIG. 19 of Parks, do not teach or suggest creating new user-customized menus. Rather, these flowcharts illustrate operations of existing (i.e., static) menus. For example, compare steps 304, 308, 312, and 316 with tabs 61-64 shown in FIGs. 6, 9, 10, and 14 of Parks.

3. The combination of Parks and Finke-Anlauff fails to teach or suggest after receiving the user-customized menu index, receiving a main menu index or a submenu index.

As stated above, Parks does not teach the user-customized menu index and a main menu index and/or a submenu index. Accordingly, Parks cannot teach after receiving the user-customized menu index, receiving a main menu index or a submenu index, as recited in Claim 1. Moreover, this deficiency is not cured by Finke-Anlauff.

Furthermore, the step of receiving the main menu index in the submenu index is received after the user-customized menu index as recited in Claim 1, so that a correct user-customized menu index is associated with desired main menu index or submenu index. For example, with reference to FIG. 4 of the present invention, the user-customized menu index of, for example, “1” is associated with the main menu index and submenu index of 1, 1, respectively, so that the “BELL VOLUME” menu is associated with the user-customized menu index of 1.

Likewise, if, for example, the main menu index and submenu index of 1, 1 is

associated with the user-customized menu index of “4,” then the “BELL VOLUME” menu would be located in the position occupied by the “INITIAL SCREEN” menu as shown in FIG. 4 of the present invention.

This concept is neither taught nor suggested by Parks or Finke-Anlauff or the combination thereof.

4. The combination of Parks and Finke-Anlauff fails to teach or suggest storing the main menu index or the submenu index in association with the user-customized menu index.

This is further illustrated with Parks’s description of the “PHONE SETUP” option starting at step 532 of FIG. 23 where the suboptions corresponding to the “PHONE SETUP” menu 88 of FIG. 8 are shown. These steps such as step 534 merely teach user customization of telephone features such as the number of rings before answering; however, these steps fail to teach or suggest a user-customized menu creating mode, as recited in Claim 1.

It was argued on Pages 6 (bottom) and 7 of the Amendment dated April 13, 2005 that “the present invention as defined in Claim 1, includes the recitation ‘storing the main menu index or the submenu index in association with the user-customized menu index.’ In other words, storing indexes selected by a user among indexes assigned to an existing main menu and a sub menu, respectively, as user menu indexes corresponding to one user

menu, is neither taught nor suggested by Parks or Finke-Anlauff or the combination thereof.”

In response, the Examiner stated “Parks teaches this feature at lines 22-26 of Column 18” (e.g., see Office Action dated July 15, 2005, pages 5 (bottom) to 6, paragraph 4).

The passage of Parks cited by the Examiner to support the rejection states: “It will be appreciated that the user input in the PHONE SETUP menu will result in the circuitry of the integrated office system 10 being configured so as to conform to these instructions.”

Parks further teaches the PHONE SETUP menu 88 displays suboptions allowing customization of phone features including the dial type (typically pulse or tone) (Column 18, Lines 7-10) and further teaches “the menus and suboptions act as graphical user interfaces, allowing a user to interact with the integrated office system” (Column 17, Lines 60-63). In other words, Parks teaches using a graphical user interface to adjust the settings such as the dial type (e.g., pulse or tone), the number of rings before answering, and other settings such as receiving faxes (e.g., see, Column 12, Lines 52-67) of the integrated office system 10. However, Parks does not teach or suggest storing the main menu index or the submenu index in association with the user-customized menu index, as recited in Claim 1. Moreover, Finke-Anlauff does not cure the deficiencies of Parks.

5. The combination of Parks and Finke-Anlauff fails to teach or suggest after receiving a main menu index or the submenu index, storing the main menu index or the

submenu index in association with the user-customized menu index.

As stated above in sections I.1 -4, Parks does not teach or suggest storing the main menu index or the submenu index in association with the user-customized menu index, nor does Parks teach or suggest the main menu index, the submenu index, or the user-customized menu index as recited in Claim 1. Accordingly, Parks cannot teach or suggest after receiving a main menu index or the submenu index, storing the main menu index or the submenu index in association with the user-customized menu index, as recited in Claim 1.

Moreover, even assuming, as the Examiner asserts, that Parks discloses a user-customized menu index, a submenu index and/or a main menu index, the Examiner equates the suboptions of Parks with the indexes as recited by the present invention (e.g., see Office Action dated January 13, 2005, paragraph 3, page 5). However, Parks merely teaches configuring the settings of the integrated office system 10 (Column 12, Lines 46-55). Thus, when a suboption is selected, the circuitry of the system is configured accordingly (Column 17, Lines 59-62). However, Parks does not teach or suggest after receiving a main menu index or the submenu index, storing the main menu index or the submenu index in association with the user-customized menu index, as recited in Claim 1.

Accordingly, for at least the above-stated reasons, the Combination of Parks and Finke-Anlauff does not render obvious Claim 1.

II. THE COMBINATION OF PARKS AND FINKE-ANLAUFF FAILS TO RENDER

OBVIOUS THE INVENTION AS CLAIMED IN CLAIM 5.

Independent Claim 5 was said to be rendered unpatentable by the combination of Parks and Finke-Anlauff. (See, Paragraph 3, at Page 2, of the Office Action dated July 15, 2005.)

As stated above with respect to the rejection of Claim 1, Parks relates to a multi-function office system and, more particularly, to a user interface system for a computer system that comprises a grid of possible user functions, and teaches a user selecting one of the options displayed, and displaying the corresponding suboption that enables the user to set features of a telephone as the user desires (e.g., see, Column 1, Lines 7-10; Column 9, Lines 33-46; and Column 10, Lines 34-38). Parks further teaches many option menus have suboptions (Column 10, Lines 34-38) and that all of the suboptions are arranged vertically (Column 12, Lines 8-9). Parks also teaches selecting a mail setup menu 73 allows a user to select among various suboptions using decision boxes 74 which can be selected by placing an “X” in the box, and that if no “X” is placed in the box, the feature is not selected (Column 12, Lines 37-43). In other words, Parks teaches selecting a menu and thereafter being able to select or modify a suboption such as a “receive fax” option, a “receive voicemail” option, and a dial type (e.g., pulse or tone) in a multi-function office apparatus such as that shown in FIG. 1 (e.g., see FIG. 6 and Column 18, Lines 5-10).

Accordingly, as taught by Parks, a user can access a menu and thereafter select a suboption to change its setting (such as the number of rings before answering) (e.g., see, FIG. 8), in which case the system would configure itself accordingly (i.e., set the number

of rings before answering).

As discussed above, Finke-Anlauff discloses a mobile telephone having a plurality of operating characteristics and means for adjusting said operating characteristics (Column 1, Lines 8-11).

It is stated that Parks teaches each and every limitation of Claim 5, except that “Parks differs from the claim in that Parks does not teach that menu the [sic] customization can be applied for portable radio phone,” which the Examiner states is taught by Finke-Anlauff (e.g., see, Office Action dated July 15, 2005, Pages 4, middle).

Claim 5 recites upon receipt of a user-customized menu creating key, switching an operating mode of the portable radio telephone to a user-customized menu creating mode; displaying a user-customized menu index input request message for requesting a user to input a user-customized menu index of a desired user-customized menu; after displaying the user-customized menu index input request message, receiving a user-customized menu index from the user; displaying a menu index input request message for requesting the user to input a menu index corresponding to user-customized menu contents desired to be stored in the received user-customized menu index; after displaying the menu index input request message, receiving from the user a main menu index or a sub-menu index; and storing the received menu index in association with the user-customized menu index.

However, the combination of Parks and Finke-Anlauff fails to teach or suggest upon receipt of a user-customized menu creating key, switching an operating mode of the portable radio telephone to a user-customized menu creating mode; displaying a user-customized menu index input request message for requesting a user to input a user-customized menu index of a desired user-customized menu; after displaying the user-customized menu index input request message, receiving a user-customized menu index from the user; displaying a menu index input request message for requesting the user to input a menu index corresponding to user-customized menu contents desired to be stored in the received user-customized menu index; after displaying the menu index input request message, receiving from the user a main menu index or a sub-menu index; and storing the received menu index in association with the user-customized menu index.

1. The combination of Parks and Finke-Anlauff fails to teach or suggest a user-customized menu index and a main menu index and/or a submenu index.

Claim 5, recites a user-customized menu index and a main menu index or a submenu index.

For at least the same reasons as set forth above in Section I. 1, with respect to Claim 1, the combination of Parks and Finke-Anlauff fails to teach or suggest a user-customized menu index and a main menu index or a submenu index, as recited in Claim 5.

2. The combination of Parks and Finke-Anlauff fails to teach or suggest switching an operating mode of the portable radio telephone to a user-customized menu creating mode.

Claim 5, recites switching an operating mode of the portable radio telephone to a user-customized menu creating mode.

For at least the same reasons as set forth above in Section I. 2, with respect to Claim 1, the combination of Parks and Finke-Anlauff fails to teach or suggest switching an operating mode of the portable radio telephone to a user-customized menu creating mode, as recited in Claim 5.

3. The combination of Parks and Finke-Anlauff fails to teach or suggest after displaying the user-customized menu index input request message, receiving a user-customized menu index from the user.

Claim 5 recites after displaying the user-customized menu index input request message, receiving a user-customized menu index from the user.

In the Office Action, the recitation of after displaying the user-customized menu index input request message, receiving a user-customized menu index from the user, a distinguishing element of the present invention, was not addressed by the Examiner.⁴ Accordingly, withdrawal of the rejection under 35 U.S.C. §103(a) is warranted.

⁴ See Office Action dated July 15, 2005 with respect to rejection of Claim 5 at pages 3-5.

4. The combination of Parks and Finke-Anlauff fails to teach or suggest displaying a menu index input request message for requesting the user to input a menu index corresponding to user-customized menu contents desired to be stored in the received user-customized menu index.

Claim 5 recites displaying a menu index input request message for requesting the user to input a menu index corresponding to user-customized menu contents desired to be stored in the received user-customized menu index.

In the Office Action, the recitation of displaying a menu index input request message for requesting the user to input a menu index corresponding to user-customized menu contents desired to be stored in the received user-customized menu index, a distinguishing element of the present invention, was not addressed by the Examiner. Accordingly, withdrawal of the rejection under 35 U.S.C. §103(a) is warranted.⁵

5. The combination of Parks and Finke-Anlauff fails to teach or suggest after displaying the menu index input request message, receiving from the user a main menu index or a sub-menu index and storing the received menu index in association with the user-customized menu index.

Claim 5 recites after displaying the menu index input request message, receiving from the user a main menu index or a sub-menu index and storing the received menu

⁵ Id.

index in association with the user-customized menu index.

For at least the same reasons as set forth above in Sections I. 1, I. 4 and I. 5, with respect to Claim 1, the combination of Parks and Finke-Anlauff fails to teach or suggest after displaying the menu index input request message, receiving from the user a main menu index or a sub-menu index and storing the received menu index in association with the user-customized menu index as recited in Claim 5.

Accordingly, as the combination of Parks and Finke-Anlauff does not teach each and every limitation of Claim 5, the rejection under 35 U.S.C. §103(a) of Claim 5 must be withdrawn.

III. THE COMBINATION OF PARKS AND FINKE-ANLAUFF FAILS TO RENDER OBVIOUS THE INVENTION AS CLAIMED IN CLAIM 8.

Independent Claim 8 was said to be rendered unpatentable by the combination of Parks and Finke-Anlauff. See, paragraph 3, at page 2, of the Office Action dated July 15, 2005.

Parks relates to a multi-function office system and, more particularly, to a user interface system for a computer system that comprises a grid of possible user functions, and teaches a user selecting one of the options displayed, and displaying the corresponding suboption that enables the user to set features of a telephone as the user desires (e.g., see, Column 1, Lines 7-10; Column 9, Lines 33-46; and Column 10, Lines

34-38). Parks further teaches many option menus have suboptions (Column 10, Lines 34-38) and that all of the suboptions are arranged vertically (Column 12, Lines 8-9). Parks also teaches selecting a mail setup menu 73 allows a user to select among various suboptions using decision boxes 74 which can be selected by placing an “X” in the box, and that if no “X” is placed in the box, the feature is not selected (Column 12, Lines 37-43). In other words, Parks teaches selecting a menu and thereafter being able to select or modify a suboption such as a “receive fax” option, a “receive voicemail” option, and a dial type (e.g., pulse or tone) in a multi-function office apparatus such as that shown in FIG. 1 (e.g., see FIG. 6 and Column 18, Lines 5-10). Accordingly, as taught by Parks, a user can access a menu and thereafter select a suboption to change its setting (such as the number of rings before answering) (e.g., see, FIG. 8), in which case the system would configure itself accordingly (i.e., set the number of rings before answering).

As discussed above, Finke-Anlauff discloses a mobile telephone having a plurality of operating characteristics and means for adjusting said operating characteristics (Column 1, Lines 8-11).

Claim 8 recites creating a menu table by designating menu indexes corresponding to service menus for a user; upon receipt of a user-customized menu creating request from the user to create a user-customized menu, switching an operating mode of the portable radio telephone to a user-customized menu creating mode; upon receipt of an index to be designated for the user-customized menu in the user-customized menu creating mode, receiving a service menu selected by inputting a main menu index or a

sub-menu index and mapping the received index to the service menu; and storing the mapped service menu in the menu table in association with the index received for the user-customized menu.

However, the combination of Parks and Finke-Anlauff fails to teach or suggest creating a menu table by designating menu indexes corresponding to service menus for a user; upon receipt of a user-customized menu creating request from the user to create a user-customized menu, switching an operating mode of the portable radio telephone to a user-customized menu creating mode; upon receipt of an index to be designated for the user-customized menu in the user-customized menu creating mode, receiving a service menu selected by inputting a main menu index or a sub-menu index and mapping the received index to the service menu; and storing the mapped service menu in the menu table in association with the index received for the user-customized menu.

1. The combination of Parks and Finke-Anlauff fails to teach or suggest creating a menu table by designating menu indexes corresponding to service menus for a user.

Claim 8 recites creating a menu table by designating menu indexes corresponding to service menus for a user.

In the Office Action,⁶ the recitation of creating a menu table by designating menu indexes corresponding to service menus for a user, was not addressed by the Examiner.

⁶ See Office Action dated July 15, 2005 with respect to rejection of Claim 8 at pages 2-3.

Accordingly, withdrawal of the rejection under 35 U.S.C. §103(a) is warranted.

Moreover, even assuming that the recitation of creating a menu table by designating menu indexes corresponding to service menus for a user, is found to have been addressed by the Examiner, then, for at least the same reasons as set forth above in Section I. 2, with respect to Claim 1, the combination of Parks and Finke-Anlauff fails to teach or suggest creating a menu table by designating menu indexes corresponding to service menus for a user, as recited in Claim 8.

2. The combination of Parks and Finke-Anlauff fails to teach or suggest switching an operating mode of the portable radio telephone to a user-customized menu creating mode.

Claim 8 recites switching an operating mode of the portable radio telephone to a user-customized menu creating mode.

For at least the same reasons as set forth above in Sections I.1 and I.2, with respect to Claim 1, the combination of Parks and Finke-Anlauff fails to teach or suggest switching an operating mode of the portable radio telephone to a user-customized menu creating mode, as recited in Claim 8.

3. The combination of Parks and Finke-Anlauff fails to teach or suggest upon receipt of a user-customized menu creating request from the user to create a user-

customized menu, switching an operating mode of the portable radio telephone to a user-customized menu creating mode.

Claim 8 recites upon receipt of a user-customized menu creating request from the user to create a user-customized menu, switching an operating mode of the portable radio telephone to a user-customized menu creating mode.

The recitation of switching an operating mode of the portable radio telephone to a user-customized menu creating mode, as recited in Claim 8, was addressed in section III. 3, above. Additionally, for at least the same reasons as set forth above in Section I. 2, with respect to Claim 1, and because the combination of Parks and Finke-Anlauff does not teach or suggest a user-customized menu creating mode, the combination of Parks and Finke-Anlauff cannot teach or suggest upon receipt of a user-customized menu creating request from the user to create a user-customized menu, switching an operating mode of the portable radio telephone to a user-customized menu creating mode, as recited in Claim 8.

4. The combination of Parks and Finke-Anlauff fails to teach or suggest receiving a service menu selected by inputting a main menu index or a sub-menu index and mapping the received index to the service menu.

Claim 8 recites receiving a service menu selected by inputting a main menu index or a sub-menu index and mapping the received index to the service menu.

First, as recited by Claim 8, the service menu is mapped to the sub-menu index or the main menu index. This is more clearly illustrated with reference to FIG. 5 of the present invention. For example the “INITIAL SCREEN” service menu corresponds with the main-menu index of “7” and the sub-menu index of “2.” This concept is neither taught nor suggested by either Parks or Finke-Anlauff or the combination thereof. Additionally, for at least the same reasons as set forth above in Sections I. 1-5, with respect to Claim 1, the combination of Parks and Finke-Anlauff fails to teach or suggest receiving a service menu selected by inputting a main menu index or a sub-menu index and mapping the received index to the service menu, as recited in Claim 8.

5. The combination of Parks and Finke-Anlauff fails to teach or suggest upon receipt of an index to be designated for the user-customized menu in the user-customized menu creating mode, receiving a service menu selected by inputting a main menu index or a sub-menu index and mapping the received index to the service menu.

Claim 8 recites upon receipt of an index to be designated for the user-customized menu in the user-customized menu creating mode, receiving a service menu selected by inputting a main menu index or a sub-menu index and mapping the received index to the service menu.

The recitation of receiving a service menu selected by inputting a main-menu index or a sub-menu index and mapping the received index to the service menu, as

recited in Claim 8, was addressed in Section III. 5. above, additionally. Additionally, for at least the same reasons as set forth above in Sections I. 1-5, with respect to Claim 1, the combination of Parks and Finke-Anlauff fails to teach or suggest upon receipt of an index to be designated for the user-customized menu in the user-customized menu creating mode, receiving a service menu selected by inputting a main-menu index or a sub-menu index, and mapping the received index to the service menu, as recited in Claim 8.

6. The combination of Parks and Finke-Anlauff fails to teach or suggest storing the mapped service menu in the menu table in association with the index received for the user-customized menu.

Claim 8 recites storing the mapped service menu in the menu table in association with the index received for the user-customized menu.

For at least the same reasons as set forth above in Section I. 4, with respect to Claim 1, the combination of Parks and Finke-Anlauff fails to teach or suggest storing the mapped service menu in the menu table in association with the index received for the user-customized menu, as recited in Claim 8.

Accordingly, as the combination of Parks and Finke-Anlauff does not teach each and every limitation of Claim 8, the rejection under 35 U.S.C. §103(a) of Claim 8 must be withdrawn.

CONCLUSION

As the Examiner has failed to make out a prima facie case for an obviousness rejection, the rejection of Claim 1, 5, and 8 must be reversed. It is well settled that in order for a rejection under 35 U.S.C. §103(a) to be appropriate, the claimed invention must be shown to be obvious in view of the prior art as a whole. A claim may be found to be obvious if it is first shown that all of the recitations of a claim are taught in the prior art or are suggested by the prior art. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974), cited in M.P.E.P. §2143.03. The Examiner has failed to show that all of the recitations of Claims 1, 5, and 8 are taught or suggested by either Parks or Finke-Anlauff or the combination thereof. Accordingly, the Examiner has failed to make out a prima facie case for an obviousness rejection.

Independent Claims 1, 5, and 8 are not rendered unpatentable by either Parks or Finke-Anlauff or the combination thereof. Thus, independent Claims 1, 5, and 8 are allowable.

Accordingly, dependent Claims 2-4, 6-7, and 9 are allowable because of their

respective dependence upon independent Claims 1, 5, and 8, respectively.

Dated: February 15, 2006

By:


Paul J. Farrell
Reg. No.: 33,494
Attorney for Applicant

DILWORTH & BARRESE. LLP
333 Earle Ovington Blvd.
Uniondale, New York 11553
(516) 228-8484 (tel)
(516) 228-8516 (fax)

CLAIMS APPENDIX

1. (Previously Presented) A method for creating a user-customized menu in a portable radio telephone having a menu table in which service menus for a user are stored in association with corresponding indexes, the method comprising the steps of:
 - upon receipt of a user-customized menu creating key, switching an operating mode of the portable radio telephone to a user-customized menu creating mode;
 - receiving a user-customized menu index in the user-customized menu creating mode;
 - after receiving the user-customized menu index, receiving a main menu index or a sub-menu index; and
 - after receiving the main menu index or the submenu index, storing the main menu index or the submenu index in association with the user-customized menu index.
2. (Original) The method as claimed in claim 1, wherein said menu index is a service menu index stored in the menu table.
3. (Original) The method as claimed in claim 1, further comprising the step of displaying a message for requesting the user to input a desired user-customized menu index after switching the operating mode of the portable radio telephone to the user-customized menu creating mode.
4. (Original) The method as claimed in claim 1, further comprising the step of displaying a message for requesting the user to input a menu index desired to be input as

menu contents in association with the received user-customized menu index.

5. (Previously Presented) A method for creating a user-customized menu in a portable radio telephone, comprising the steps of:

upon receipt of a user-customized menu creating key, switching an operating mode of the portable radio telephone to a user-customized menu creating mode;

displaying a user-customized menu index input request message for requesting a user to input a user-customized menu index of a desired user-customized menu;

after displaying the user-customized menu index input request message, receiving a user-customized menu index from the user;

displaying a menu index input request message for requesting the user to input a menu index corresponding to user-customized menu contents desired to be stored in the received user-customized menu index;

after displaying the menu index input request message, receiving from the user a main menu index or a sub-menu index; and

storing the received menu index in association with the user-customized menu index.

6. (Original) The method as claimed in claim 5, wherein the menu index is an index of a service menu previously stored in the portable radio telephone.

7. (Original) The method as claimed in claim 5, further comprising the step of releasing the user-customized menu creating mode after storing the menu index in

association with the user-customized menu index.

8. (Previously Presented) A method for creating a user-customized menu in a portable radio telephone, comprising the steps of:

creating a menu table by designating menu indexes corresponding to service menus for a user;

upon receipt of a user-customized menu creating request from the user to create a user-customized menu, switching an operating mode of the portable radio telephone to a user-customized menu creating mode;

upon receipt of an index to be designated for the user-customized menu in the user-customized menu creating mode, receiving a service menu selected inputting a main menu index or a sub-menu index and mapping the received index to the service menu; and

storing the mapped service menu in the menu table in association with the index received for the user-customized menu.

9. (Original) The method as claimed in claim 8, further comprising the step of releasing the user-customized menu creating mode after creating the user-customized menu table.

EVIDENCE APPENDIX

There is no evidence submitted⁷ pursuant to 37 C.F.R. §1.130, §1.131, or §1.132, or entered by the Examiner and relied upon by the Appellant.

⁷ See Office Action dated July 15, 2005 with respect to rejection of Claim 8 at pages 2-3.

RELATED PROCEEDINGS APPENDIX

There are no known decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 C.F.R. §41.37.